

Application No.: 10/763,727
Amendment dated: June 6, 2005
Reply to Non-Compliant Amendment dated: May 5, 2005

REMARKS/ARGUMENTS

Claims 10-21 are pending in the application. Claims 10-21 have been amended.

Claims 11-15 and 17-21 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 10, 13-16, and 19-21 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,690,551 to Shiraishi et al. (hereinafter "Shiraishi"). Claims 11-12 and 17-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shiraishi. The title and abstract were objected to as not being descriptive due to the matter that was carved out due to the restriction requirement.

Objections to the Abstract, Title and Drawings

The title and abstract were objected to as not being descriptive due to the matter that was carved out due to the restriction requirement. The title has been amended. The abstract has been amended to meet word count requirements of the Patent Office. No new matter has been added.

The drawings were objected to for informalities and for not being properly identified in the top margin as "Replacement Sheet" as required by 37 C.F.R. §1.121. Figures 3 and 7 were amended to correct the informalities cited by the Examiner. Replacement drawings are being submitted to comply with the Examiner's request. The specification was amended to include reference to element 612, which had been present in the drawings. No new matter was added.

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Rejections under 35 U.S.C. §112

Claims 11-15 and 17-21 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the claims were rejected for using the word “system” without a proper antecedent. The claims have been amended to use words with a proper antecedent.

Rejections under 35 U.S.C. §102

Claims 10, 13-16, and 19-21 were rejected under 35 U.S.C. §102(e) as being anticipated by Shiraishi. Shiraishi discloses a precise positioning actuator to be fixed with a head slider with at least one head element and with a support for precisely positioning the at least one head element. The precise positioning actuator has a pair of movable arms capable of displacing in response to a drive signal applied to the actuator (*See Abstract*).

Shiraishi does not teach or suggest that the layer of insulative material is wider than the layer of conductive material, as recited in claims 10 and 16. Shiraishi describes the multi-layered structure by stating:

Each of the piezoelectric elements 51b and 52b has, as shown in FIG. 6, a multi-layered structure of alternately laminating piezoelectric material layers 60, signal electrode layers 61 and ground (common) electrode layers 62. By applying voltage across the signal electrode layers 61 and the ground (common) layers 62, the piezoelectric material layers 60 expand and contract. The piezoelectric material layer 60 is made of material that expands and contracts by reverse piezoelectric effect or by electrostrictive effect. The signal electrode layers 61 are electrically connected to the A channel signal terminal 22b or the B channel signal terminal 22c, and the ground (common) electrode layers 62 are electrically connected to ground (common) terminal 22d or 22e, shown in FIGS. 3 and 4.

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(Shiraishi, Col. 7, Lines 13-26).

This section of Shiraishi does not mention that the layer of insulative material is wider than the layer of conductive material, nor does any other section of Shiraishi. The drawings, specifically Figure 6 which illustrates the multi-layered structure, do not illustrate the layer of insulative material being wider than the layer of conductive material either. Further, Figure 6 could not possibly illustrate this as it is showing a longitudinal sectional illustration of the multi-layered structure, only able to show thickness and length. Applicants respectfully submit, therefore, that elements of claim 10 and 16 are neither shown nor suggested by Shiraishi. Claims 13-15 and 19-21 depend from claims 10 and 16, respectively. Accordingly reconsideration and withdrawal of the rejection of claims 10, 13-16, and 19-21 under 35 U.S.C. §102(e) is respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 11-12 and 17-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shiraishi.

However, Shiraishi is a reference under §102(e) according to the Office Action. Shiraishi is also assigned to the TDK Corporation of Tokyo, Japan. Further, SAE Magnetics Ltd., the obligated assignee at the filing of this invention is a wholly owned subsidiary of TDK Corporation dating back to August of 1986 (*see* attached web page). As such, inventions assigned to SAE Magnetics Ltd. and inventions assigned to TDK Corporation are considered to be commonly owned for purposes of §103(c). *See* MPEP 706.02(1)(2), Example 1.

35 U.S.C. §103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one

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or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

TDK Corporation commonly owned Shiraishi and the pending application at the time the claimed invention was made. Therefore, Applicants submit that Shiraishi may not be used as a prior art reference per 35 U.S.C. §103(c).

Based on the arguments above, reconsideration and withdrawal of the rejection of claims 11-12 and 17-18 under 35 U.S.C. §103(a) is respectfully requested.

The Applicant respectfully submits that this application is in condition for allowance. A Notice of Allowance is earnestly solicited.

The Examiner is invited to contact the undersigned at (408) 975-7500 to discuss any matter concerning this application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. **11-0600**.

Respectfully submitted

KENYON & KENYON

Dated: June 6, 2005

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AMENDMENTS TO THE DRAWINGS

The eleven (11) pages of formal replacement drawings, Figures 1-11, which accompany the present amendment are to comply with the Notice of Non-Compliant Amendment under 37 C.F.R. §1.121. The formal drawings are labeled "Replacement Sheets" and replace any previously submitted drawings.

Attachment: Annotated Sheets Showing Changes
Replacement Sheets

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ANNOTATED SHEET SHOWING CHANGES

~~1/0~~ 1/11

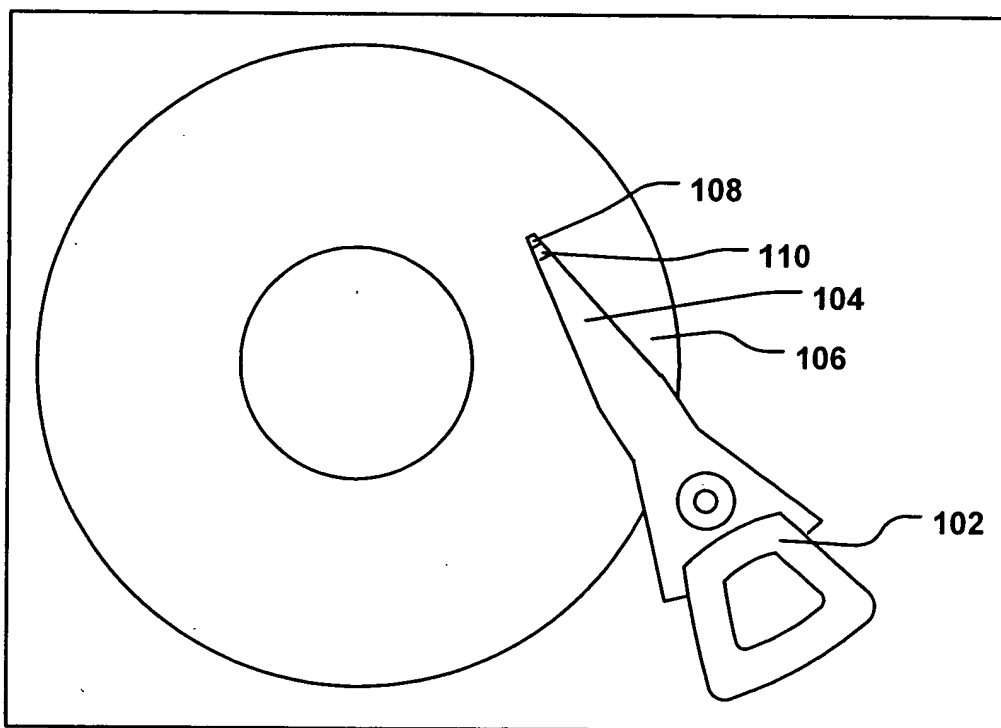


Figure 1
(Prior Art)

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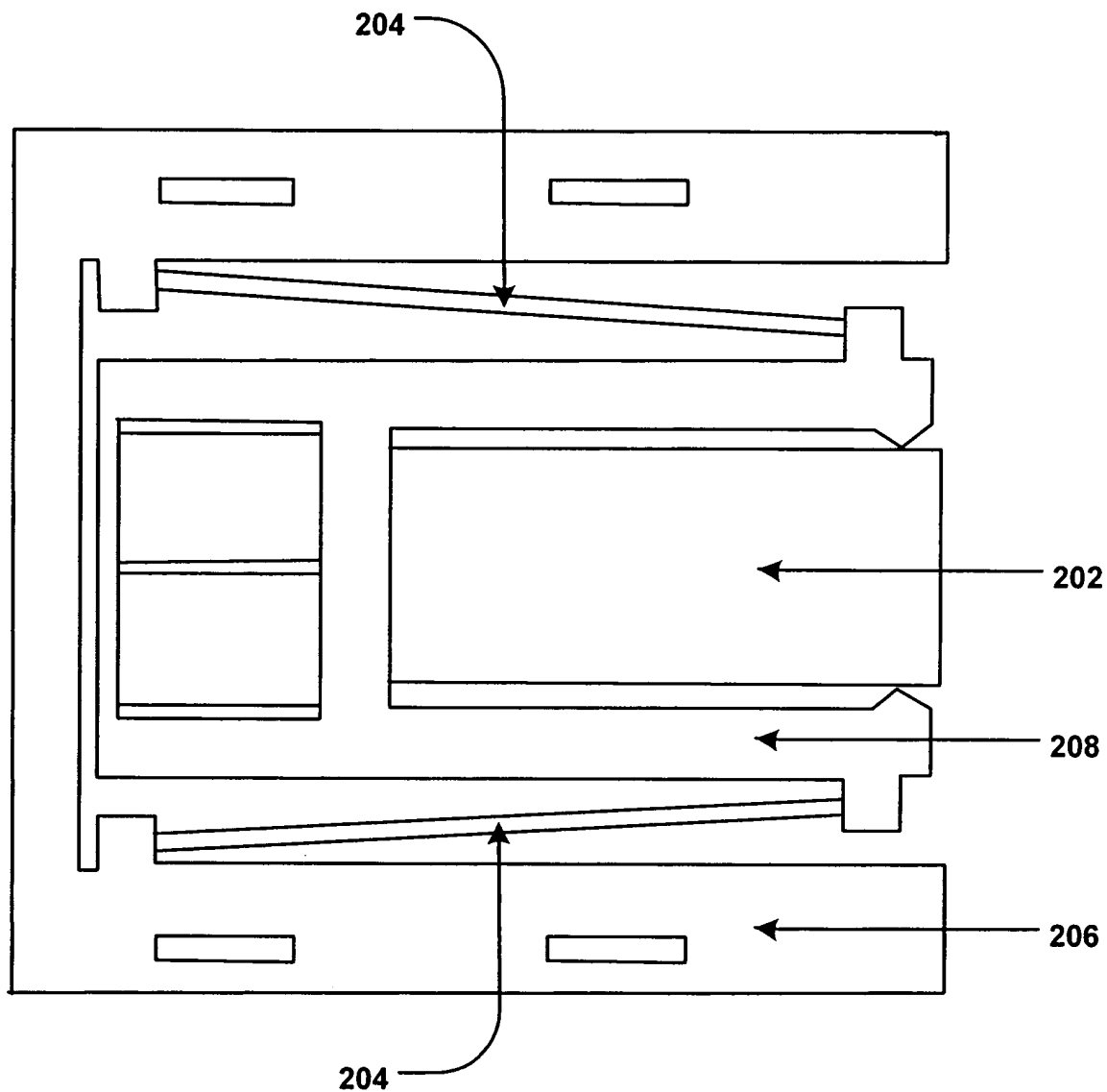


Figure 2
(Prior Art)

(Figure 3 & 4 are
on same sheet)

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connecting
reference
arm
added

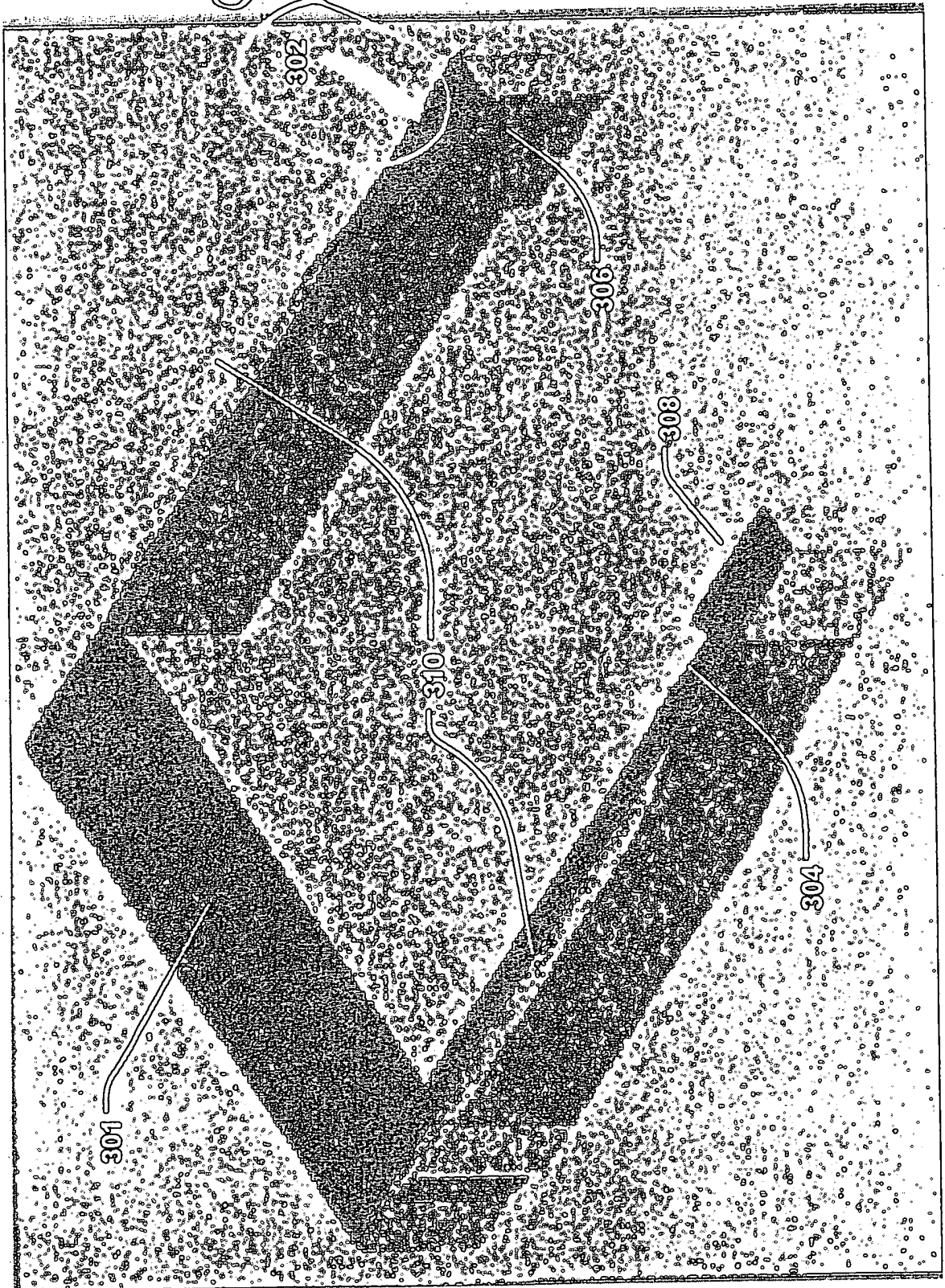


Figure 3

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ANNOTATED SHEET SHOWING CHANGES

Figure 4 is
(on same sheet as)
figure 3

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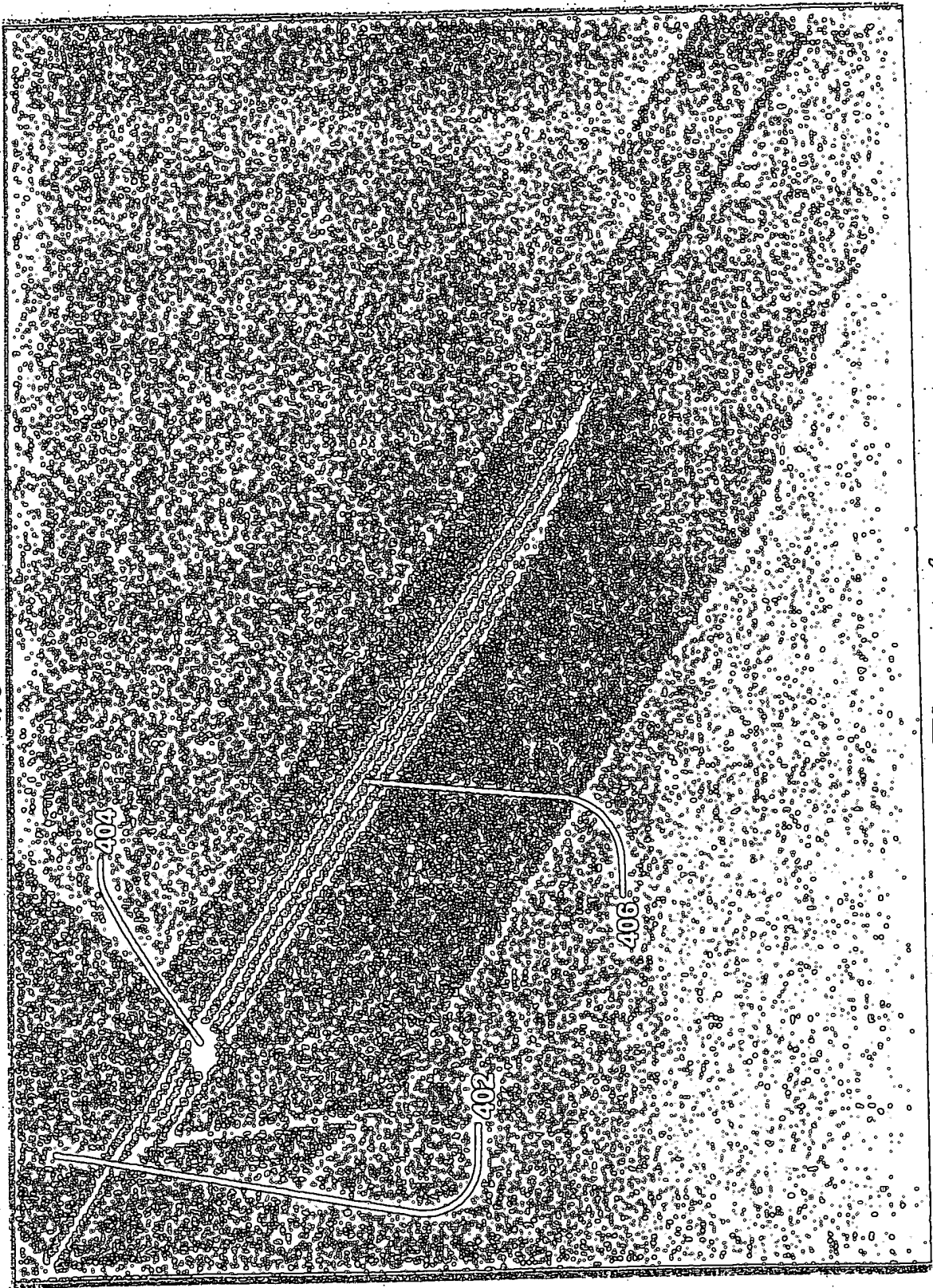


Figure 4

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~~5/9~~



Fig. 5a

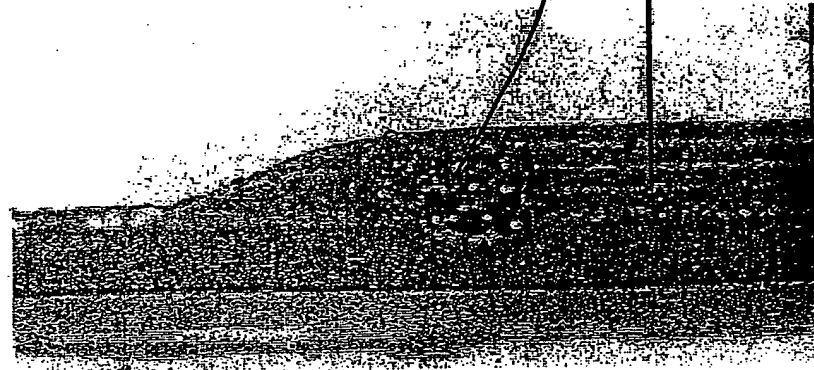


Fig. 5b



Fig. 5c

Figure 5

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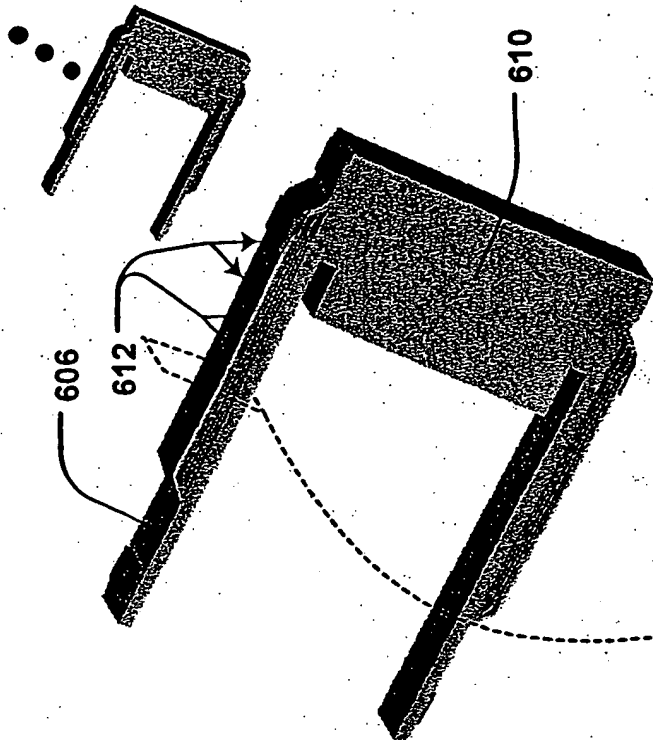


Fig. 6b

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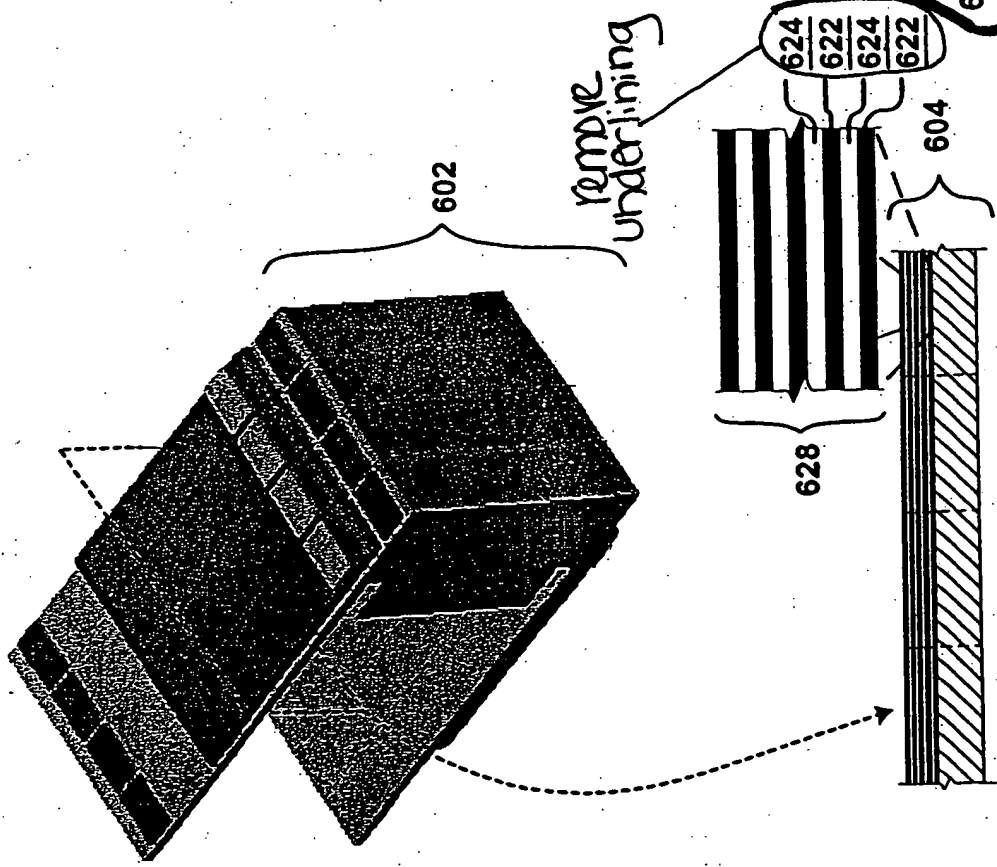


Fig. 6a

~~Figure 6~~

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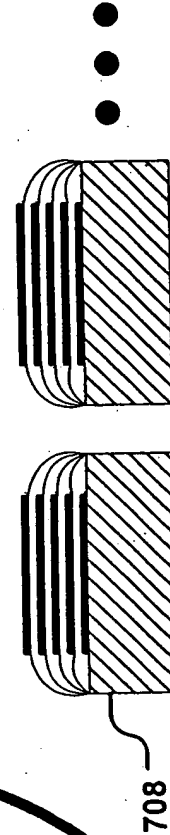
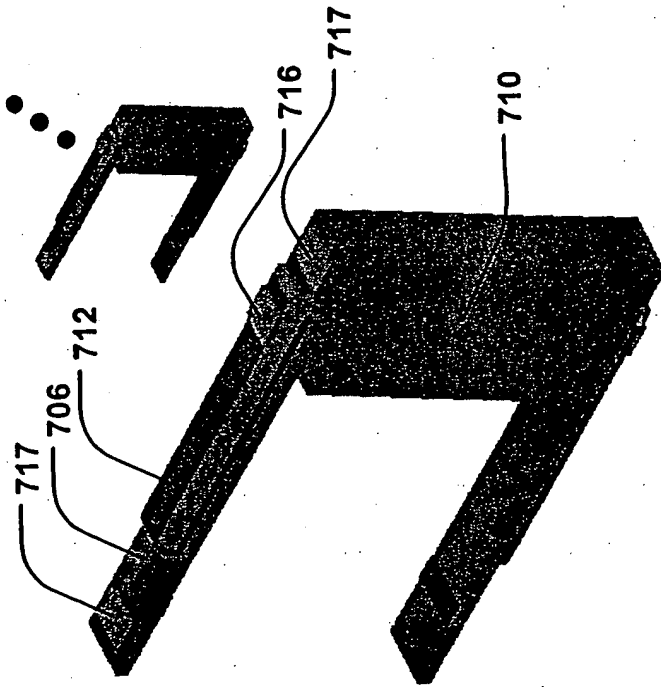


Fig. 7b

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~~7/9~~

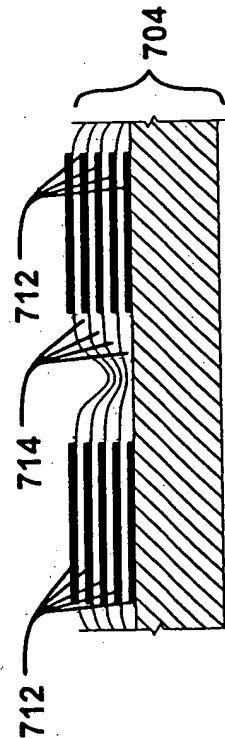
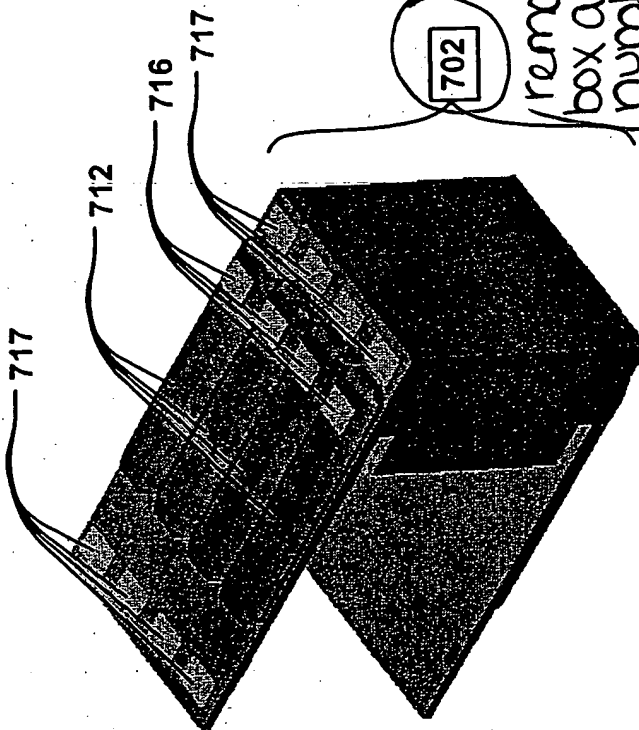


Fig. 7a

~~Figure 7~~

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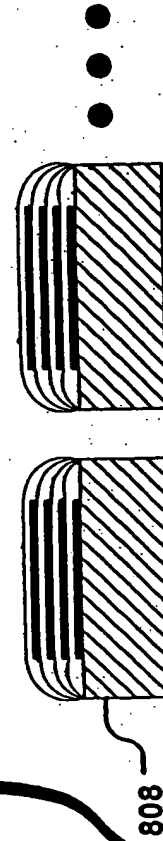
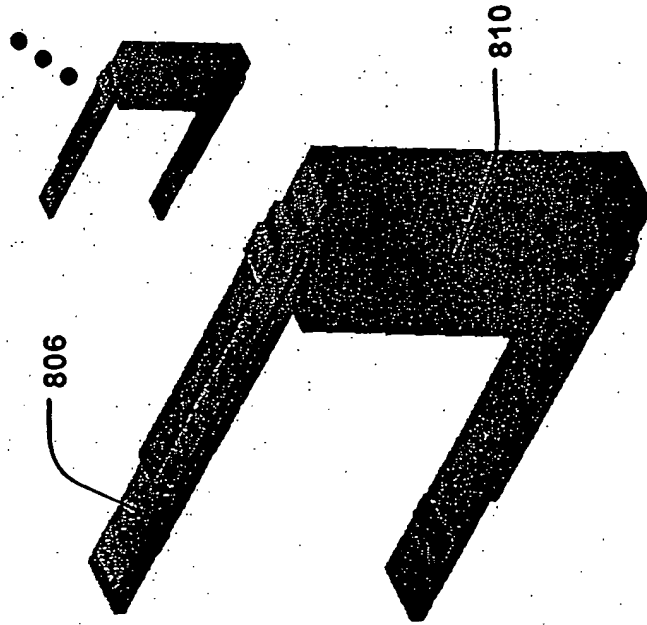
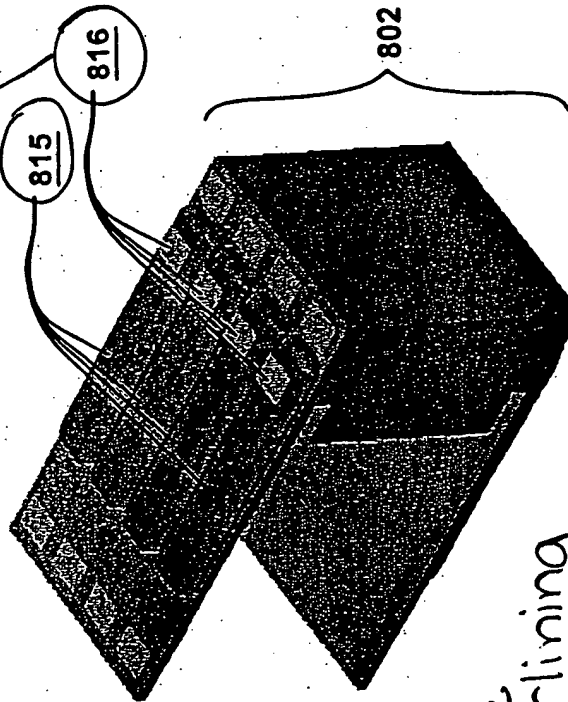


Fig. 8b

~~Figure 8~~

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Remove Underlining
~~8/9~~



Remove Underlining

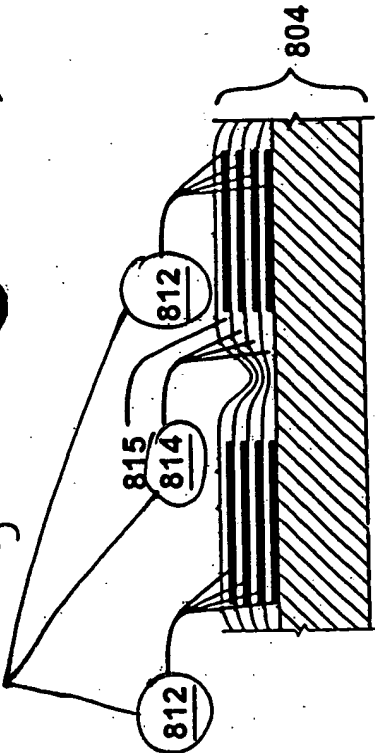


Fig. 8a

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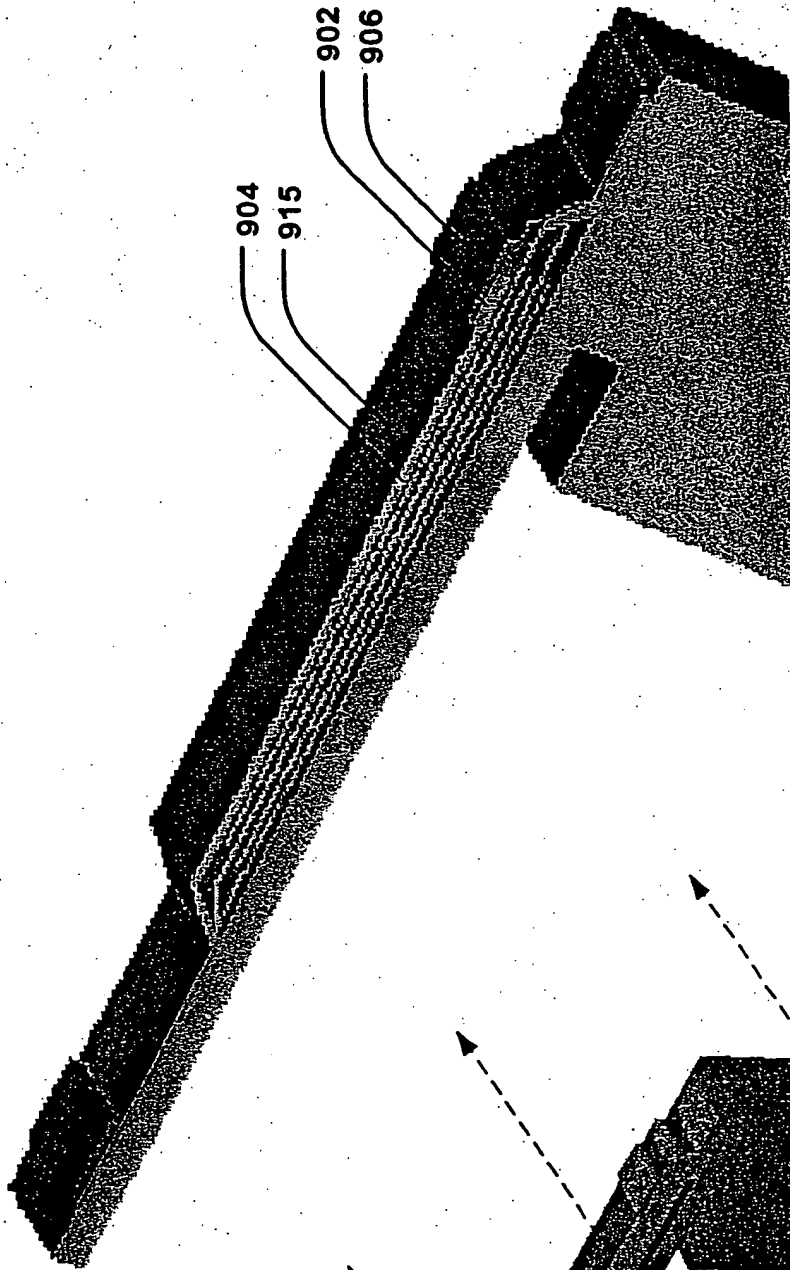


Figure 9

